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Technology Center 2100

In re Application of : D. Lawrence et al.
Application No. 09/919,413
Filed: July 31, 2001
For: ONLINE TRANSACTION RISK
MANAGEMENT

DECISION ON PETITION
TO MAKE SPECIAL

This is a decision on the petition to make special filed December 7, 2001. In light of the content of the petition, it will be treated first in view of M.P.E.P. §708.02(XI): Inventions For Countering Terrorism, then M.P.E.P. §708.02(VIII) Accelerated Examination.

M.P.E.P. §708.02 (XI), which sets out the prerequisites for a grantable petition for Inventions For Countering Terrorism under 37 C.F.R. § 102(d), states in relevant part:

International terrorism as defined in 18 U.S.C. 2331 includes "activities that - (A) involve violent acts or acts dangerous to human life that are a violation of the criminal laws of the United States or of any State, or that would be a criminal violation if committed within the jurisdiction of the United States or of any State; [and] (B) appear to be intended - (i) to intimidate or coerce a civilian population; (ii) to influence the policy of a government by intimidation or coercion; or (iii) to affect the conduct of a government by assassination or kidnapping..." The types of technology for countering terrorism could include, but are not limited to, systems for detecting/identifying explosives, aircraft sensors/security systems, and vehicular barricades/disabling systems.

Applicants who desire that an application relating to inventions for countering terrorism be made special should file a petition with the petition fee under 37 CFR 1.17(h) requesting the Patent and Trademark Office to make the application special. The petition for special status should be accompanied by a statement explaining how the invention contributes to countering terrorism.

Petitioner's submission fails to meet the criteria set out with respect to countering terrorism in M.P.E.P. §708.02(XI). The claimed invention is directed to managing risk related to online transactions which does not directly relate to countering violent acts or acts dangerous to human life intended to intimidate a population or influence the policy or conduct of a government. While applicant indicates that the invention could be related to national security, this does not persuasively establish that the invention represents an advancement in the field of countering terrorism.

Next, M.P.E.P. §708.02, Section VIII which sets out the prerequisites for a grantable petition for Accelerated Examination under 37 C.F.R. § 102(d) states in relevant part:

A new application (one which has not received any examination by the examiner) may be granted special status provided that applicant (and this term includes applicant's attorney or agent) complies with each of the following items:

- (A) Submits a petition to make special accompanied by the fee set forth in 37 CFR 1.17(h);
- (B) Presents all claims directed to a single invention, or if the Office determines that all the claims presented are not obviously directed to a single invention, will make an election without traverse as a prerequisite to the grant of special status...;
- (C) Submits a statement(s) that a pre-examination search was made, listing the field of search by class and subclass, publication, Chemical Abstracts, foreign patents, etc. A search made by a foreign patent office satisfies this requirement;
- (D) Submits one copy each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record; and
- (E) Submits a detailed discussion of the references, which discussion points out, with the particularity required by 37 CFR 1.111 (b) and (c), how the claimed subject matter is patentable over the references.

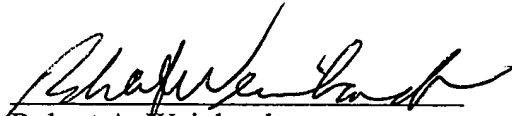
In those instances where the request for this special status does not meet all the prerequisites set forth above, applicant will be notified and the defects in the request will be stated. The application will remain in the status of a new application awaiting action in its regular turn. In those instances where a request is defective in one or more respects, applicant will be given one opportunity to perfect the request in a renewed petition to make special. If perfected, the request will then be granted. If not perfected in the first renewed petition, any additional renewed petitions to make special may or may not be considered at the discretion of the Group Special Program Examiner.

Applicant's submission is deficient in that it does not clearly comply with (B) and (E) above. With respect to (B), there is no statement that applicant will make an election without traverse if the Office determines that all the claims are not obviously directed to a single invention. With respect to (E), the discussion of the references does not point out how the *claimed* subject matter is patentable over the references. The discussion of the references asserts that the references do not teach a risk quotient reflecting the amounts of legal, regulatory, financial and reputational risk in the transaction. However, claims 1 and 16 for example do not recited the type of risk argued, i.e. legal, regulatory, financial and reputational risk. Further, claim 23 does not specifically call for generating the risk quotient, instead it is received. Finally, claim 22 is a product by process claim directed to a signal indicating risk. The assertions made with regard to the references do not match the scope of the independent claims.

Accordingly, the petition is **DISMISSED**. The application file is being forwarded to Central Files to await examination in its proper turn based on its effective filing date. Any request for reconsideration must be filed within TWO MONTHS of the mailing date of this decision.

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On Petition

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A handwritten signature in black ink, appearing to read 'Robert A. Weinhardt', written over a horizontal line.

Robert A. Weinhardt
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